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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,970	01/24/2001	Olga Bandman	PF-0321-2 DIV	7462

27904 7590 04/15/2003

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EXAMINER

CARLSON, KAREN C

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 04/15/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/769,970

Applicant(s)

BANDMAN ET AL.

Examiner

Karen Cochran Carlson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-31 and 33-42 is/are pending in the application.
- 4a) Of the above claim(s) 22,23 and 33-42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 and 26 is/are allowed.
- 6) ☐ Claim(s) 24,27-29 and 31 is/are rejected.
- 7) ☐ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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This Office Action is in response to Paper #8, filed February 10, 2003. Claims 1-21 and 32 have been canceled. Claims 22, 23, and 33-42 have been withdrawn from further consideration by the Examiner because these claims are drawn to non-elected inventions. Claims 24-31 are under examination.

### **Withdrawal of Rejections**

The rejection of Claims 24, 27-29, and 32 under the judicially created doctrine of double patenting over claims 1-4 of U. S. Patent No. 5, 817,479 is withdrawn.

The rejection of Claims 24- under 35 U.S.C. 112, second paragraph is withdrawn.

The rejection of Claims 24 and 27-32 under 35 U.S.C. 112, first paragraph, for lack of written description regarding biologically active or immunogenically active fragments of SEQ ID NO: 2 is withdrawn.

The rejection of Claims 24, 27-29, and 32 under 35 U.S.C. 102(e) as being anticipated by Au-Young et al. (USP 5, 817,479) is withdrawn.

The rejection of Claims 24, 27, 28, and 32 under 35 U.S.C. 102(a) as being anticipated by Hillier et al. (September, 1996; Genome Res. 6(9): 807-828) is withdrawn.

The rejection of Claims 24 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Myers (January 1996; Genbank Accession G15342) is withdrawn.

The rejection of Claims 24, 27, 28, 29, and 32 under 35 U.S.C. 102(e) as being anticipated by Nezu et al. (USP 6,265,194, priority to December 1997) is withdrawn.

### **Maintenance of Rejections**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

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and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24, 27-29, and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not teach polynucleotides encoding a polypeptide have 90% identity to SEQ ID NO: 2. The specification does not teach polynucleotides that are 90% identical to SEQ ID NO: 9 and encode a polypeptide having any function. Without a statement regarding the activity of a polynucleotides encoding a polypeptide have 90% identity to SEQ ID NO: 2 or polynucleotides that are 90% identical to SEQ ID NO: 9 and encode a polypeptide having any function one skilled in the art cannot know the metes and bounds of the claimed polynucleotides. For example, the claims encompass inactive and/or antagonist kinases, and the like. Therefore, there is no functional parameter of activity for these polynucleotides and therefore the claims lack written description.

Applicants urge from pages 8-15 that the Examiner has ignored the limitation that the claimed polynucleotides encodes a polypeptide comprising a naturally occurring amino acid sequence, or comprise a naturally occurring polynucleotide sequence and has attempted to introduce functional limitations into these claims where no functional limitation is present. As noted in the rejection, without a statement regarding the activity of the polynucleotides encoding a polypeptide have 90% identity to SEQ ID NO: 2 or polynucleotides that are 90% identical to SEQ ID NO: 9 and encode a polypeptide having any function one skilled in the art cannot know the metes and bounds of the claimed polynucleotides. Applicants have not described these polynucleotides, whether naturally occurring or not. If Applicants desire a variant of a polynucleotide encoding SEQ ID NO: 2 or having SEQ ID NO: 9, then functional language will be placed into the claim so that one skilled in the art has an assayable activity to

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determine if their polynucleotides is anticipated by Applicants. Applicants are referred to Example 14 of the Written Description Guidelines. Note that DAPK-2 is a deduced amino acid sequence and that its kinase activity is decided by sequence homology to VRK1 (page 18 and Example III at page 50). The potential to assess kinase activity is prophetically taught in Example X at page 56). Therefore, the specification does not teach polynucleotides encoding a polypeptide having 90% identity to SEQ ID NO: 2 or polynucleotides that are 90% identical to SEQ ID NO: 9 and encode a polypeptide having any function.

**New Objections**

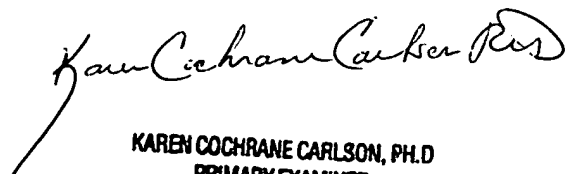
Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 24 and 25 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 703-308-0034. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on 703-308-2329. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER